

**TERMINAL DISCLAIMER TO OBIATE A PROVISIONAL DOUBLE PATENTING
REJECTION OVER A PENDING "REFERENCE" APPLICATION**

Docket Number (Optional)
11321-P012USD2

In re Application of: Richard E. Smalley et al.

Application No.: 10/035,075

Filed: December 28, 2001

For: Method for Cutting Nanotubes

The owner*, William Marsh Rice University, of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of any patent granted on pending **reference** Application Number 10/027,671, filed on December 21, 2001, as such term is defined in 35 U.S.C. 154 and 173, and as the term of any patent granted on said **reference** application may be shortened by any terminal disclaimer filed prior to the grant of any patent on the pending **reference** application. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and any patent granted on the **reference** application are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

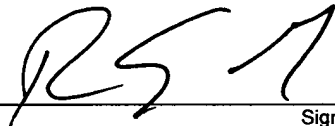
In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 and 173 of any patent granted on said **reference** application, "as the term of any patent granted on said **reference** application may be shortened by any terminal disclaimer filed prior to the grant of any patent on the pending **reference** application," in the event that: any such patent: granted on the pending **reference** application: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as shortened by any terminal disclaimer filed prior to its grant.

Check either box 1 or 2 below, if appropriate.

1. ☐ For submissions on behalf of a business/organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the business/organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2. ☒ The undersigned is an attorney or agent of record. Reg. No. 38,150



Signature

April 7, 2005

Date

Ross Spencer Garsson

Typed or printed name

512.370.2870

Telephone Number

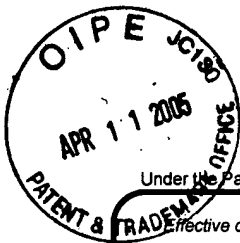
- ☒ Terminal disclaimer fee under 37 CFR 1.20(d) is included.

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Form PTO/SB/96 may be used for making this statement. See MPEP § 324.

This collection of information is required by 37 CFR 1.321. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PTO/SB/17 (11-04)

Approved for use through 07/31/2006. OMB 0651-0032

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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FEE TRANSMITTAL
For FY 2005☐ Applicant claims small entity status. See 37 CFR 1.27**TOTAL AMOUNT OF PAYMENT (\$)** **130.00****Complete if Known**

| | |
|----------------------|---------------------------|
| Application Number | 10/035,075 |
| Filing Date | December 28, 2001 |
| First Named Inventor | Richard E. Smalley et al. |
| Examiner Name | Peter Lish |
| Art Unit | 1754 |
| Attorney Docket No. | 11321-P012USD2 |

METHOD OF PAYMENT (check all that apply)☒ Check ☐ Credit Card ☐ Money Order☒ Deposit Account ☐ NoneDeposit
Account
Number
Deposit
Account
Name

23-2426

Winstead Sechrest & Minick P.C.

The Director is hereby authorized to: (check all that apply)

- ☐ Charge fee(s) indicated below
- ☐ Charge fee(s) indicated below, **except for the filing fee**
- ☒ Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17
- ☒ Credit any overpayments

to the above-identified deposit account.

☐ Other (please identify):**WARNING:** Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**FEE CALCULATION****1. BASIC FILING FEE**

| <u>Fee Description</u> | <u>Fee (\$)</u> | <u>Small Entity Fee (\$)</u> | <u>Fee Paid(\$)</u> |
|------------------------|-----------------|------------------------------|---------------------|
| Utility Filing Fee | 790 | 395 | |
| Design Filing Fee | 350 | 175 | |
| Plant Filing Fee | 550 | 275 | |
| Reissue Filing Fee | 790 | 395 | |
| Provisional Filing Fee | 160 | 80 | |

Subtotal (1) \$**FEE CALCULATION** (continued)**2. EXTRA CLAIM FEES**

| <u>Fee Description</u> | <u>Fee (\$)</u> | <u>Small Entity Fee (\$)</u> |
|---|-----------------|------------------------------|
| Each claim over 20 | 50 | 25 |
| Each independent claim over 3 | 200 | 100 |
| Multiple dependent claims | 360 | 180 |
| For Reissues, each claim over 20 and more than in the original patent | 50 | 25 |
| For Reissues, each independent claim more than in the original patent | 200 | 100 |

Total Claims **Extra Claims** **Fee (\$)** **Fee Paid (\$)**- 20 or HP = $\frac{\text{Total Claims}}{20}$ x $\frac{\text{Extra Claims}}{20}$ = $\frac{\text{Fee Paid}}{\text{Fee}}$
HP = highest number of total claims paid for, if greater than 20**Indep. Claims** **Extra Claims** **Fee (\$)** **Fee Paid (\$)**- 3 or HP = $\frac{\text{Indep. Claims}}{3}$ x $\frac{\text{Extra Claims}}{3}$ = $\frac{\text{Fee Paid}}{\text{Fee}}$
HP = highest number of independent claims paid for, if greater than 3**Multiple Dependent Claims** **Fee (\$)** **Fee Paid (\$)****Subtotal (2) \$****3. OTHER FEES**

| <u>Fee Description</u> | <u>Fee (\$)</u> | <u>Small Entity Fee (\$)</u> | <u>Fee Paid(\$)</u> |
|-------------------------------------|-----------------|------------------------------|---------------------|
| 1-month extension of time | 120 | 60 | |
| 2-month extension of time | 450 | 225 | |
| 3-month extension of time | 1,020 | 510 | |
| 4-month extension of time | 1,590 | 795 | |
| 5-month extension of time | 2,160 | 1,080 | |
| Information disclosure stmt. fee | 180 | 180 | |
| 37 CFR 1.17(q) processing fee | 50 | 50 | |
| Non-English specification | 130 | 130 | |
| Notice of Appeal | 500 | 250 | |
| Filing a brief in support of appeal | 500 | 250 | |
| Request for oral hearing | 1,000 | 500 | |
| Other: Terminal Disclaimer | | | 130.00 |

Subtotal (3) \$ 130.00**SUBMITTED BY**

Signature

Registration No.
(Attorney/Agent)

38.150

Telephone 512.370.2870

Name (Print/Type)

Ross Spencer Garsson

Date April 7, 2005

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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